SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 1435

GULF OIL CORPORATION, ADDRESSOGRAPH MULTIGRAPH CORPORATION and RALPH COBB,
Petitioners,

v.

WILLIAM H. WOLOWITZ,
Respondent.

HUMBLE OIL & REFINING COMPANY,
Petitioner,

v.

WILLIAM H. WOLOWITZ,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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Dated: May 29, 1967

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Petitioners, defendants-appellants below, pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit entered in this case on March 20, 1967.

Opinions Below

The *per curiam* opinion of the Court of Appeals (App. 1a-3a)* is reported at 153 USPQ 10, F. 2d . It affirms an opinion of the United States District Court for the District of Columbia (JA 135-168)* reported at 255 F. Supp. 100.

Jurisdiction

The judgment of the Court of Appeals (App. 4a) was entered on March 20, 1967, and an order (App. 5a) denying a petition for rehearing *en banc*, Judge Wright dissenting, was entered on April 28, 1967.

The jurisdiction of this Court is invoked pursuant to 28 U. S. C. § 1254(1).

Questions Presented

1. Whether the issuance of a patent by the Patent Office imbues the patent in a subsequent infringement action with the benefit of a presumption of administrative correctness, "strengthened by the statutory presumption of validity," when the Patent Office issues patents even if in doubt as to their patentability, and especially when the Patent Office has not cited the most pertinent prior art.

2. Whether the Courts below, which exercise supervisory authority over the Patent Office by virtue of 35 U. S. C. § 145, and which have an obligation to articulate and to apply the correct standard of patentability for the guidance of the Patent Office, applied the correct legal test

*In this petition, references to "App." are to the appendix to the petition; references to "JA" are to the Joint Appendix in the Court of Appeals.

of patentability when they did not properly measure the patent against the legal standard of obviousness, but instead held the patent in suit valid because there was "no suggestion in the [prior art] references that they be combined to produce an inventor's results," a standard recently rejected by this Court.

Statutes Involved

35 U. S. C. § 103 provides:

> "§ 103. *Conditions for patentability; non-obvious subject matter*
>
> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

35 U. S. C. § 141 provides in pertinent part:

> "§ 141. *Appeal to Court of Customs and Patent Appeals*
>
> "An applicant dissatisfied with the decision of the Board of Appeals [of the Patent Office] may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title."

35 U. S. C. § 145 provides in pertinent part:

"§ 145. *Civil action to obtain patent*

"An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia . . ."

35 U. S. C. § 282 provides in pertinent part:

"§ 282. *Presumption of validity; defenses*

"A patent shall be presumed valid. . . . The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it."

Statement of the Case

This is an action for infringement of United States patent 2,582,187, entitled PRINTING MACHINE FOR DUPLICATING INDICIA, which issued to respondent William H. Wolowitz on January 8, 1952. The case was tried in June of 1965, and on May 31, 1966 the District Court entered its Findings of Fact, Conclusions of Law, and Judgment holding the patent valid and infringed (JA 135-168). The District Court made findings detailing the construction and operation of the patented and accused devices and the prior art. None of the findings relating to these aspects of the case was challenged in the Court of Appeals, and none is challenged here.

The Wolowitz patent in suit (JA 181-197) relates to a simple, manually operated printing device used to record on sales slips information concerning retail credit transactions. It is designed to print on the sales slip fixed in-

formation from a credit customer's embossed credit card (to identify the customer), and variable information from settable printing wheels (to reflect the dollar amount of the transaction). Both the fixed and the variable information are printed in readable characters (i.e., Arabic numbers) for the information of the customer and the sales clerk, and are also printed in a code so that the sales slip thus printed may be handled by business machines which read the code and use the information in automated accounting processes.

All of the individual elements of the device of the Wolowitz patent were admittedly old (JA 31-34, 137; Finding 70, JA 162).

Also old were devices capable of printing sales slips with both fixed information from a customer's credit card and variable information from settable printing wheels.* And it was old to equip such devices to enable them to print their fixed and variable information both legibly and in code,** District Court's Finding 52 (JA 156):

> "It was old in the art that printing machines for the preparation of business records might print code if desired . . . long before Wolowitz and Vogt, it was well known . . . to use closed bed printing machines with rotary printing wheels like the prior art Vogt machine to print information in code."

The only difference between such prior art printing devices and the device of the Wolowitz patent is that the fixed and variable code marks printed on a sales slip by Wolowitz's device are aligned to correspond to the same pattern—

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*Vogt patent 2,606,494 (JA 208-211; Finding 50, JA 155), and the 1935 Addressograph machine (JA 214-215; Findings 55 and 70, JA 157, 162).

**Young patent 2,020,925 (Finding 69; JA 161-162) and British patent 538,016 (JA 216-223; Finding 51, JA 155).

whereas in the prior art they were not so aligned (District Court's Finding 53; JA 156).

The District Court found as a fact that none of the prior art patents petitioners rely upon were cited by the Patent Office (Finding 71, JA 162-163).

The District Court accurately found the facts with respect to the patented structure and the prior art, and it isolated the difference between the patented structure and the prior art. But the District Court failed to measure that difference against the statutory requirement of nonobviousness.

Instead, in holding the Wolowitz patent valid it adopted an improper rule of law, namely that references cannot be combined to defeat patentability when there is ". . . no suggestion in the references that they be combined to produce an inventor's results" (255 F. Supp. at 102; JA 137).

In arriving at this holding of validity, the District Court observed that the Wolowitz patent was entitled to a presumpion of administrative correctness, reinforced by the presumption of validity (255 F. Supp. at 102-103; JA 139):

> ". . . said normal presumption of administrative correctness is *strengthened* by the statutory presumption of validity accorded to the patent in suit in unequivocal terms by the first sentence of 35 U. S. C. § 282."*

The Court of Appeals, without any discussion of the structures of the Wolowitz patent or the prior art, affirmed with the observation that (App. 2a):

> ". . . we are convinced that upon the whole record he [the trial Judge] applied the established judicial standards of patent validity and legal doctrine to the evidence in this case . . ."

*Emphasis in quotations is ours unless the contrary is noted.

Reasons for Granting the Writ

1. Patents Issued When the Patent Office Is in Doubt Are Not Entitled in Infringement Actions to a Presumption of Validity, Much Less a "Presumption of Administrative Correctness Strengthened by the Statutory Presumption of Validity"

This case raises a question akin to that presented in *Application of Hofstetter,* 362 F. 2d 293 (CCPA 1966), in which certiorari was granted April 10, 1967 (Docket No. 1002). *Hofstetter* involves an appeal to the Court of Customs and Patent Appeals from the Patent Office's refusal to grant a patent. In granting certiorari, this Court has agreed to review the propriety of the practice, followed by the Patent Office and the Court of Customs and Patent Appeals, of resolving doubts regarding patentability in favor of applicants in proceedings to obtain patents, and of granting patents, notwithstanding doubt as to their patentability.

The instant case is a patent infringement litigation, as distinguished from an appeal from the Patent Office to the Court of Customs and Patent Appeals. In addition to the issue raised in *Hofstetter,* this case raises the further important question of whether a patent, issued by the Patent Office applying its "rule of doubt," is entitled to a "presumption of administrative correctness . . . strengthened by the statutory presumption of validity" in later litigation for its alleged infringement.

The same policy considerations which condemn the Patent Office "rule of doubt" also militate against any presumption of validity or of administrative correctness in favor of issued patents. To presume such patents valid in infringement litigation, and thus tend to immunize them from attack, is to foster unwarranted monopolies. This

undeserved presumption frequently discourages any defense against baseless suits for patent infringement, the defense of such suits being expensive and the result uncertain. Such a rule is inconsistent with recent rulings of this Court, *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966), and *Brenner* v. *Manson*, 383 U. S. 519 (1966).

Nor can the presumption of validity, whatever its effect in these circumstances, conceivably be *strengthened* by a presumption of administrative correctness.* The presumption of administrative correctness and the presumption of validity are one and the same. And whatever it is called, it can be based only on the considered administrative decision of the Patent Office that a patent should issue. There is nothing in the Patent Office record relating to its examination of patent applications which gives any clue with respect to whether or not the "rule of doubt" was or was not involved in any particular instance.**

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*This novel doctrine, applied by the District Court and approved by the Court of Appeals, is the result of a misapplication of the doctrine of *Reynolds* v. *Aghnides*, 356 F. 2d 367 (D. C. Cir. 1966), and related cases, which doctrine provided the conflict which brought the *Hofstetter* case to this Court. The rule of the *Aghnides* case is that when a Court is reviewing the Patent Office's *refusal* to grant a patent, it should resolve doubts as to patentability not in favor of the applicant, but rather "in favor of the correctness of administrative . . . action." The *Aghnides* rule is a salutary one, and we are confident this Court will choose it in preference to the *Hofstetter* rule of resolving doubt as to patentability in favor of the applicant. But the doctrine endorsed by the Courts below in adopting what they conceive to be the converse of the *Aghnides* rule, that the Patent Office's decision to *grant* a patent gives such a patent a presumption of administrative correctness strengthened by a statutory presumption of validity, is manifestly unsound.

**Where an examiner has resolved his doubt in favor of the applicant he is prevented from expressly stating so. *Ex parte Overstrom*, 1903 C. D. 263 (1903): "The rules expressly provide that when a claim is rejected, the reasons therefor should be given; but there is no provision of the rules or statutes which require that the reasons for the allowance of a claim should be stated by the Examiner when he considers the claim to be patentable. While it may be proper in

A patent issued without such a considered decision—and instead issued by application of a "rule of doubt"—is not entitled to any presumption in its favor. And it certainly is not entitled to the benefit of one presumption "strengthened" by another.

It is a bootstrap argument to suggest that a patent, which the Patent Office has issued notwithstanding doubt as to its patentability, should be insulated from attack in infringement litigation by any presumption whatever. The Commissioner of Patents, in recently seeking to change the "rule of doubt," has acknowledged as much, 48 *Journal of the Patent Office Society*, 475, 476 (August, 1966):

> "I wish to state here that it is our judgment that any application covering an invention of doubtful patentability should not be allowed, unless and until such doubt is removed in the course of examination and prosecution, since *otherwise the resultant patent would not justify the statutory presumption of validity . . .*"

Any such attempted change in the "rule" in the Patent Office (assuming it can proceed in face of CCPA holdings like *Hofstetter*) does not, of course, affect the patent in suit here or the hundreds of thousands of outstanding

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some cases to state the reasons why the claim should be allowed, such expressions as those objected to are not proper and are not called for. It is a well-recognized principle of law that doubts as to the patentability of the claim may be waived in favor of the applicant; but this should be a mental process and should not be formally expressed in the record. A patent when issued by this Office is *prima facie* a valid grant, and no direct statement should occur in the record of a patent that the validity of the same is doubtful. This fact of course may often be inferred from the nature of the actions in the case; but it should never be positively stated by an Examiner in the record of a patent that doubts are resolved in favor of the allowance of any claim or claims."

patents issued prior to any attempt to change the "rule." The validity of these patents, indeed their alleged presumptive validity, is a matter of great public interest.

Finally, neither presumption can be any better than the record in the Patent Office on which it is based, *California Research Corporation* v. *Ladd,* 356 F. 2d 813, 819 (D. C. Cir. 1966). In the present case, the District Court's finding of fact (Finding 71, JA 162-163) that *none* of the prior art relied upon by petitioners had been considered by the Patent Office is such as to deprive the Wolowitz patent of any presumption of either validity or of administrative correctness, because there had been no administrative decision, made in light of the full facts, to which a presumption of correctness or validity can attach.

The "rule of doubt" applied by the Patent Office and its reviewing tribunals is manifestly unsound, and contrary to the Constitutional requirement that undeserved patent monopolies not be granted. Its unsoundness taints any presumption which might otherwise operate in favor of a patent in subsequent infringement litigation.

2. The Erroneous Decisions of the Courts Below Set Improper Standards for the Patent Office

The decisions of the Courts below in this case are clearly inconsistent with this Court's recent interpretation of the nonobviousness requirement of 35 U. S. C. § 103, so painstakingly set forth in the recent case of *Graham* v. *John Deere Co.,* 383 U. S. 1 (1966).

The District Court's opinion (JA 135-168), written shortly after *Graham,* contains not a single reference to the opinion in *Graham.* Instead of applying the nonobviousness test which this Court articulated so fully in *Graham,* the District Court applied an inapposite and outmoded test regarding the propriety of "combining" prior art refer-

ences. In reaching its conclusion of patent validity, the District Court declared that such references could not be combined to defeat patentability if there is:

> ". . . no suggestion in the references that they be combined to produce an inventor's results." (255 F. Supp. at 102; JA 137)

The *per curiam* affirmance of the Court of Appeals, although citing and purporting to follow *Graham,* merely endorsed the erroneous test applied by the District Court. The *per curiam* opinion reads in part:

> ". . . we are convinced that upon the whole record he [the trial Judge] applied the established judicial standards of patent validity and legal doctrine to the evidence in this case . . ." (App. 2a)

Plainly, the test referred to by the District Court and endorsed by the Court of Appeals is not the nonobviousness test prescribed by statute and fully delineated by this Court. Instead, it is a test specifically rejected by this Court in *Calmar, Inc.* v. *Cook Chemical Co.,* 383 U. S. 1 (1966), a companion case to *Graham* and reported with it. In *Calmar* the Court of Appeals had held the patent in suit valid because it found:

> ". . . nothing in the prior art suggesting Scoggin's [the patentee's] unique combination of these old features . . ." (383 U. S. 30)

This test was thrown out. This Court held the patent in *Calmar* invalid for failure to measure up to the statutory criterion of nonobviousness—notwithstanding the conceded fact that the patent in suit differed from what

had gone before it in a fashion not "suggested" by the prior art.*

The test of patentability applied in the instant case by the Courts below is manifestly erroneous. It is in conflict with the recent decisions of this Court, and of every Court of Appeals which has heard and determined an "obviousness" case since *Graham:* Second Circuit, *Formal Fashions, Inc.* v. *Braiman Bows, Inc.,* 369 F. 2d 536 (2 Cir. 1966); Third Circuit, *Jones Knitting Corporation* v. *Morgan,* 361 F. 2d 451 (3 Cir. 1966); Fourth Circuit, *Tidewater Patent Development* v. *Kitchen,* 371 F. 2d 1004 (4 Cir. 1967); Fifth Circuit, *Zero Manufacturing Co.* v. *Mississippi Milk Pro. Ass'n,* 358 F. 2d 853 (5 Cir. 1966), cert. denied 385 U. S. 841 (1966); Sixth Circuit, *United States Plywood Corp.* v. *General Plywood Corp.,* 370 F. 2d 500 (6 Cir. 1966); Seventh Circuit, *Skirow* v. *Roberts Colonial House, Inc.,* 361 F. 2d 388 (7 Cir. 1966); Eighth Circuit, *Kell-Dot Industries, Inc.* v. *Graves,* 361 F. 2d 25 (8 Cir. 1966), cert. denied 385 U. S. 842 (1966); Ninth Circuit, *Bentley* v. *Sunset House Distributing Corp.,* 359 F. 2d 140 (9 Cir. 1966); Tenth Circuit, *Griswold* v. *Oil Capital Valve Co.,* F. 2d , 152 USPQ 95 (10 Cir. 1966).

Moreover, it is an error which is likely to be repeated in Courts of the District of Columbia, and perhaps more

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*In this connection, it is interesting to note the reaction of Judge Mehaffy, author of the Court of Appeals opinion in *Calmar,* in a later decision on the question of obviousness, *Kell-Dot Industries, Inc.* v. *Graves,* 361 F. 2d 25, 30 (8 Cir. 1966), cert. denied 385 U. S. 842 (1966):

> "There was nothing in the prior art in *Calmar* suggesting the combination of the old features . . . Nonetheless, the Supreme Court was convinced that the patent in *Calmar* must fall when the proper interpretation is made of § 103, since the differences in the claims of the Calmar patent and the pertinent prior art would have been obvious to a person reasonably skilled in that art."

importantly in the Patent Office, unless appropriate corrective action is taken.

The Court of Appeals for the District of Columbia Circuit shares supervisory authority over the Patent Office with the Court of Customs and Patent Appeals.* The decisions of these two Courts are now in direct conflict on the proper interpretation of the obviousness requirement of 35 U. S. C. § 103. The Court of Customs and Patent Appeals has consistently rejected the test applied by the Courts below in the present case, and instead has patterned its obviousness decisions on the requirements this Court laid down so carefully in *Graham*: *Application of Lyons*, 364 F. 2d 1005, 1012 (CCPA 1966); *Application of Winslow*, 365 F. 2d 1017, 1020 (CCPA 1966); *Application of Chamblee*, 368 F. 2d 262, 266 (CCPA 1966); *Application of Fortess*, 369 F. 2d 1009, 1017 (CCPA 1966); and *Application of Siebentritt*, 372 F. 2d 566, 567-8 (CCPA 1967).

The confusion in the Patent Office which will inevitably result from its being required to adhere to two irreconcilable rules is plainly predicatable. It is of importance to the sound administration of the patent system that the cause of this confusion be eliminated.

It is equally plain that the test applied by the Courts below in the instant case should be rejected. It is inconsistent with *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966), and its application by the Patent Office would be to perpetuate what was referred to in *Graham* (p. 18) as "a notorious difference between the standards [of patentability] applied by the Patent Office and by the Courts."

*An unsuccessful applicant for a patent may either pursue an appeal to the Court of Customs and Patent Appeals, under 35 U. S. C. § 141; or file a civil action in the United States District Court for the District of Columbia, under 35 U. S. C. § 145, from which an appeal may be taken to the Court of Appeals for the District of Columbia Circuit.

Conclusion

For the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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Dated: May 29, 1967

APPENDIX A

OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT, 153 USPQ 10, F. 2d (MARCH 20, 1967)

Before BURGER, TAMM and ROBINSON, *Circuit Judges.*

PER CURIAM: These actions, consolidated for trial and hearing, are before this court on appeal by defendant-appellants from a judgment of the United States District Court entered May 31, 1966. That judgment held valid appellee Wolowitz's Patent No. 2,582,187, covering a "Printing Machine for Duplicating Indicia" and further held that the present appellants had infringed the valid patent. While accepting generally the learned trial judge's findings of facts, appellants based their appeals upon claims that the trial judge applied improper legal standards of patent validity to the facts in the record and, consequently, erred in the conclusions he reached, both as to patent validity and infringement.

The trial judge filed a detailed opinion which included 71 findings of fact and his conclusions of law based upon these findings. *Wolowitz* v. *Gulf Oil Corp., et al.,* 255 F. Supp. 100.

The Supreme Court has but recently redefined the standards of patentability of inventions, with particular reference to the congressional addition of obviousness to patent requirements, by the enactment of § 103 of the Patent Act of 1952, 35 U. S. C. § 103 (1964 ed.). In *Graham* v. *John Deere Co.,* 383 U. S. 1, 14 speaking for the Court, Mr. Justice Clark, in defining the import of § 103 on prior patent requirements, said:

> "Patentability is to depend, in addition to novelty and utility, upon the 'non-obvious' nature of the 'subject

matter sought to be patented' to a person having ordinary skill in the pertinent art."

Speaking further to the same § 103, Mr. Justice Clark pointed out that:

> ". . . The emphasis on non-obviousness is one of inquiry, not quality, and, as such, comports with the constitutional strictures.
>
> "While the ultimate question of patent validity is one of law, *A. & P. Tea Co.* v. *Supermarket Corp., supra,* at 155, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy." *Graham* v. *John Deere, supra,* at 17.

Applying these criteria to the trial judge's findings of facts and conclusions of law, we are convinced that upon the whole record he applied the established judicial standards of patent validity and legal doctrine to the evidence in this case, not only to the issue of obviousness but also

to other involved questions of patentability and infringement.

We note further that there is substantial evidence in the record to support each of the trial judges findings of fact. Rule 52 Federal Rules of Civil Procedure.

> "This Court possesses no empirical expertise to set against the careful and reasonable conclusions of lower courts on purely factual issues. When, as here, resolution of disputed factual issues turns largely on an assessment of the relative credibility of witnesses whose testimonial demeanor was observed only by the trial court the rule has particular force." *Berenyi* v. *District Director, Immigration and Naturalization Service,* 35 U. S. L. Week 4147 (U. S. Jan. 23, 1967).

Affirmed.

APPENDIX B

JUDGMENT OF THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

Judgment

These cases came on to be heard on the record on appeals from the United States District Court for the District of Columbia, and were argued by counsel.

ON CONSIDERATION WHEREOF, it is ordered and adjudged by this court that the judgment of the District Court appealed from in these cases is hereby affirmed.

It is further ORDERED by the court that appellee herein recover from appellants his taxable costs on these appeals, and have execution therefor.

Per Curiam

Dated: March 20, 1967

APPENDIX C

ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT, ENTERED APRIL 28, 1967

Before: Bazelon, Chief Judge; and Danaher, Burger, Wright, McGowan, Tamm, Leventhal and Robinson, Circuit Judges, in Chambers.

Order

On consideration of appellants' petition for rehearing *en banc* and of appellee's response thereto, it is

ORDERED by the court *en banc* that appellants' aforesaid petition is denied.

Per Curiam.

Circuit Judge Wright would grant appellants' petition for rehearing *en banc*.

FILED
MAY 29 1967
JOHN F. DAVIS, CLERK

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BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

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BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

STATEMENT OF THE CASE

This is just another patent case, turning, as most such cases do, on questions of fact. It is typical of that class of cases where an individual inventor submitted his invention to a large manufacturer which adopted and used the invention. The District Court emphasized the copying by Defendants (R. 135), and also stressed the fact that Defendants made "a rather ingenious, but unsuccessful, attempt to design around the Wolowitz patent in suit" (R. 141; see also Finding 46 at R. 154).

In their answer to the Complaint, Defendants admitted that they knew of no pertinent prior patents but indicated such would be cited "when they become known to Defendants" (R. 6). We therefore turn to the defenses urged below. These defenses were devised, after the suit was on file, in a desperate effort to justify the flagrant copying of Defendants.

Petitioners limited themselves before the Court of Appeals to the five defenses set forth in their "Statement of Points" on appeal, filed Pursuant to Rule 15 of the Court of Appeals and set forth in a footnote hereto.*

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* STATEMENT OF POINTS

Pursuant to the provisions of Rule 15 of the General Rules of the United States Court of Appeals for the District of Columbia Circuit the following are the points on which appellants intend to rely on the instant appeals:

1. There was no unexpected result or unusual function and no patentable invention in combining conventional printing wheels with an embossed credit card to print fixed and variable information in a machine-readable code. The court below erred in holding that the Wolowitz patent conferred a monopoly on such unpatentable combination that is embodied in the accused Addressograph data recorder.

2. The objective of the Wolowitz patent was to print the IBM code. The court erred in holding that the compact bar code printed by the accused Addressograph data recorder was equivalent to the IBM code.

3. The Wolowitz patent discloses as its distinguishing mechanical feature a series of transversely movable crossheads for setting individual printing elements or type faces in a pattern across a printing bed. The accused Addressograph data recorder does not have such transversely moving crossheads or any equivalent thereof and does not set printing elements or type faces in a pattern across a printing bed. The court erred in failing to confine the Wolowitz patent to printing machines containing such transversely movable crossheads and equivalents for setting printing elements or type faces in a pattern across the printing bed.

Item 1 of the "Statement of Points" is based on the factual assumption that the accused Addressograph machine involves just two old parts. The description of that machine is plainly incomplete (R. 143-5). Item 1 does not directly attack patent validity but urges that the patent should not cover said two old parts; hence in essence asserts non-infringement.

Item 4 of the "Statement of Points" is the only one dealing with the validity of the patent, and alleges that the patent in suit is anticipated by Hoffman 1,919,219. The District Court dismissed this defense as being "without genuine merit" (R. 136), and Defendants challenged this ruling in the "Statement of Points" on appeal. In the District Court, Defendants also proposed to combine the Hoffman patent with British patent No. 3303, but the District Judge rejected the combination as "impractical" (R. 160), and Defendants thereafter dropped the proposed combination of prior patents as they did not mention said British patent either in their "Statement of Points" or in their brief on appeal.

The points that Petitioners have raised here but which were not covered in their "Statement of Points" on appeal, have, of course, been abandoned, *Aro Mfg. Co.* v. *Convertible Top Replacement Co.*, 377 U.S. 476, 491, Fn. 9.

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4. The Wolowitz patent was anticipated by expired Hoffman patent No. 1,919,219. The court erred in holding that the defense of anticipation was without genuine merit.

5. The functional claims of the Wolowitz patent, when properly construed in accordance with the file history of the patent and the provisions of 35 U.S.C. § 112, are limited to a printing machine for printing the IBM code and embodying transversely movable assemblies for setting printing elements or type faces in the pattern of the IBM code. The trial court erred in not so limiting the Wolowitz claims.

Dated: August 15, 1966

The First Question Raised in the Petition Is Based Upon Mere Dicta of the District Court and Upon an Incorrect Assumption of Facts

Petitioner reads the decision of the District Court out of context and overlooks the essential holdings of fact. A brief summary of its holdings is as follows (R. 136-9):

The District Court rejected the defense that Plaintiff's patent was anticipated (fully met) as being "without genuine merit", saying that the real question was whether it was obvious to combine references (R. 137). The Court then held that Petitioner's alleged expert Margach was not really an expert at all whereas Plaintiff had produced two qualified experts to show that the proposed combination of references were impractical and unobvious, whereupon the Court concluded (R. 138):

> "The Court finds that the weight of the evidence presented on the technological questions in this case favors the position of Plaintiff Wolowitz that his patent in suit is valid and infringed by the accused Addressograph machine."

Reading this in the light of what the Court said on the preceding page (R. 137), it is clear that the Court was speaking about the question of obviousness. Thus even if the burden of proof were upon the Plaintiff, he proved his case by the "weight of the evidence."

In the next paragraph (R. 138), the District Court in effect said that the evidence in favor of Plaintiff was so clear that even if the Patent Office had rejected the Wolowitz application and Wolowitz had applied

to the District Court to overturn the adverse ruling of the Patent Office, that

> "the Commissioner might well have been authorized [by this Court] to issue such patent" (matter in brackets added).

This in effect was saying that even if a heavy administrative presumption had been adverse to the Plaintiff, the Court still "might well have" ruled for him. Thereupon the District Court made Findings of Fact 52, 53 and 63 to the effect that the proposed combinations of prior patents, if made, would be "impractical" and fell far short of meeting the invention of the claims (R. 155, 160).

In view of the foregoing, it is apparent that the District Court felt that the Wolowitz invention was clearly patentable. That the Patent Office took the same view is plainly shown in the file history of the patent (Def. Ex. 2-U at p. 61) where it is indicated that at an oral interview between the attorney and the Examiner the claims were "agreed upon as clearly allowable". **Thus, Petitioners' extensive discussion of the alleged "rule of doubt" is inapplicable to the facts of the case.**

Petitioner urges that the District Court held that the Patent Office did not "consider" the prior art relied on by Defendant. The Court made no such holding. It merely held that the patents relied on by the Defendants were not "cited" by the Patent Office (R. 162). Considering the fact that the District Court found that the combinations of prior patents were "impractical" (R. 156, 160), it is clear that "the Patent Office representatives qualified in this field did not regard them as sufficiently relevant even to cite",

United Shoe Machinery Corp. v. *Industrial Shoe Machinery Corp.,* CA-1, 335 F. 2d 577, 579 (Fn. 2); *United States* v. *Adams,* 383 U.S. 39, 52; *Copease* v. *American Photocopy Equipment Co.,* CA-7, 298 F. 2d 772, 777.

As for the presumption of validity, 35 U.S.C. 282 provides:

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

Since the weight of the evidence favored Plaintiff, not Defendant (R. 138), it is unnecessary, as far as this case is concerned, to determine the weight to be given to the presumption. It is noted, however, that numerous courts have held that clear and convincing evidence is required to invalidate a patent, *Mumm* v. *Decker & Sons,* 301 U.S. 168, 171; *Walt Disney Productions* v. *Fred A. Niles, Com. CTR Inc.,* CA-7, 369 F. 2d 230, 234; *Samuelson* v. *Bethlehem Steel Corp.,* CA-5, 323 F. 2d 944, 947.

Petitioner's Second Question Is Inapplicable to This Case as Well as Unsound

The District Court reached the following conclusion (R. 163):

> "3. The Wolowitz patent is valid because the claimed combination of individually old mechanical elements 'as a whole' would not have been obvious at the time Wolowitz made his invention to a person having ordinary skill in the art of business data recording machines. 35 U.S.C. § 103."

This precisely meets the rules of law laid down in *Graham* v. *John Deere Co.,* 383 U.S. 1.

Petitioner makes reference to the holding of the District Court that it is improper to combine references if there is no suggestion in them that they may be combined to produce the inventor's result. The question is not really involved here because no attack upon the validity of the patent, based upon a combination of references, was made in the "Statement of Points" on appeal. But even assuming that such question is before this Court, it is noted that Defendants produced no evidence other than the references themselves in an effort to suggest the combination. The only combination of references urged against the validity of the patent at the trial was Hoffman and British patent No. 3033 (R. 62-3).* Petitioner's alleged expert witness Margach merely said that to put these patents together would be "straightforward engineering" and referred to no facts outside the patents themselves to show that it was obvious to combine them. Without such "outside" facts it is clear, that if the patents themselves did not suggest the combination, that the combination was unobvious.

Petitioner urges that the Court of Appeals of the District of Columbia is in conflict with the Court of Customs and Patent Appeals on the question of combining references. However, the District Court's support for its holding about combining references was

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* At the trial, Petitioner referred to the combination of Vogt 2,606,494 and British patent 538,016, saying that such combination was the same as the accused Addressograph machine (R. 52-3). Hence this was really a defense of non-infringement. But even if this Court considers this combination of references to be before it, the same discussion that we gave for the Hoffman-British 3033 combination applies, for in presenting the defense Petitioner's witness Margach referred to no facts outside the patents themselves to show obviousness (R. 52-3).

based on its prior decision in *Multi-Fastener Corp.* v. *Ladd,* 229 F. Supp. 46, 48, which, in turn, relied on the Court of Customs and Patent Appeals, which held the same thing, see *In re Hortman* (C.C.P.A.) 264 F. 2d 911, 914:

> "It is well settled that references may not be combined where 'there is no suggestion in either of the references that they can be combined'" * * *

SUMMARY AND CONCLUSIONS

The questions stated by Petitioner are not based on the facts of this case: But even if those questions were involved, the Courts below did not err respecting them.

Respectfully submitted,

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